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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,417	06/26/2003	Arun V. Shastry	02280.003530	4883

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NEW YORK, NY 10112

EXAMINER

FAISON GEE, VERONICA FAYE

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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01/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/606,417

Applicant(s)

SHASTRY ET AL.

Examiner

Veronica Faison-Gee

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5,7,8,10-12,15-17,19,20,22,23,25,28-30,33,34 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5,7,8,10-12,15-17,19,20,22,23,25,28-30,33,34 and 37-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5, 7, 8, 10-12, 15-17, 19, 20, 22, 23, 25, 28-30, 33, 34, 37-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims were amended to include the limitation "wherein the volume in milliliters of the colorant and carrier combined per gram of the fat or wax base is 0.09 to 0.45 milliliters per gram".

It is unclear to the Examiner how the volume of the colorant and carrier is achieved there appears to be no way to calculate this volume because no density for the dye is given. It appears to the Examiner that the values claimed can only be achieved by using the vol. of sat. solution. Please clarify how to obtain the volume in milliliters of the colorant and carrier combined per gram of the fat or wax base is 0.09 to 0.45 milliliters per gram.

Therefore the Examiner is examining the claims as previously presented until the 112 rejection has been overcome.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 7, 8, 10-17, 19, 20, 22, 23, 25, 28-30, 33, 34, and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reitnauer et al (2003/0101902) in view of Kojima et al (US Patent 6,450,615).

Reitnauer et al teaches a method for forming a mark on a food product wherein the ink composition comprises a wax and colorant, and may further comprise a resin and antioxidant (abstract and page 1 para. 0011). The reference further teaches that the resolution of the mark can be at least 50 dpi and the food product may be an egg, cheese, fruit or a confectionary (page 1 para. 0008-0009). The wax may be selected from beeswax, candelilla wax, carnauba wax, polyethylene glycol and cocoa butter wherein the wax is present in the amount of 50 to 99 percent by weight (page 2 para. 0019-0020). The colorant may include a pigment or dye (page 2 para. 0025-0026), specifically FD&C Green no. 3, FD&C Blue no.1 and 2, FD&C Red no 40 and FD&C yellow no. 6 all of which are disclosed by Applicant specification in paragraph 0027. The ink composition may further comprise a stabilizer (page 2 para. 0027). The ink composition may include other conventional hot melt ink components, wherein the amount of the components may be included in the ink to provide the desired viscosity (page 3 para. 0030). Reitnauer et al also teaches that the ink may be used in a

conventional hot melt ink jet printer, piezoelectric printer (page 3 para. 0033-0034).

Reitnauer et al fail to teach the specific printing method.

Kojima et al teaches a droplet ejection apparatus that may be used with various types of ink compositions (abstract). The reference further teaches that the printing apparatus has a resolution of 300 dpi or higher (col. 2 lines 39-50). The reference discloses that in general ink used for a droplet ejection apparatus has a viscosity of 8 to 15 cp in the case of a hot melt ink composition and the surface tension for any of the inks would be in the range between 10 and 70 dyne/cm (col. 3 lines 26-31).

Therefore it would have been obvious to one of ordinary skill in the art to use the ink composition as taught by Reitnauer et al in the apparatus of Kojima, because Kojima apparatus may be used with hot melt ink compositions like that taught by Reitnauer et al.

Response to Arguments

Applicant's arguments filed 10-18-07 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims which have been amended to include to wherein the volume in milliliters of the colorant and carrier combined per gram of the fat or wax base is 0.09 to 0.45 milliliters per gram" have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., colorant is added to the carrier in an amount close to the solubility limit of the

carrier for the solvent) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Reitnauer does not teach a water-soluble colorant into a fat or wax base using a carrier for the colorant. The Examiner respectfully disagrees. As shown above Reitnauer teaches the same water-soluble colorant as Applicant, even though these particular colorant are not used in an example does not make them less obvious to use as Reitnauer recites "the ink may include a colorant or dye, which provides color to the ink".

Nonpreferred embodiments can be indicative of obviousness. *Merck & Co. v. Biocraft Laboratories Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1989); *In re Lamberti* 192 USPQ 278 (CCPA 1976); *In re Kohler* 177 USPQ 399 (CCPA 1973); *In re Mills* 176 USPQ 196 (CCPA 1972); *In re Bozek* 163 USPQ 545 (CCPA 1969); *In re Meinhardt* 157 USPQ 270 (CCPA 1968); *In re Boe* 148 USPQ 507 (CCPA 1976); *In re Nehrenberg* 126 USPQ 383.

A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed. Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976); *In re Lamberti* 192 USPQ 278 (CCPA 1976); *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Preda* 159 USPQ 342 (CCPA 1968); *In re Van Mater* 144 USPQ 421 (CCPA

1965); *In re Jacoby* 135 USPQ 317 (CCPA 1962); *In re LeGrice* 133 USPQ 365 (CCPA 1962).

Applicant argues that Reitnauer does not teach using glycerin carrier for the colorant. However it is the position of the Examiner that once the components of the ink composition have been combined, including the glycerin, that the all the components are part of the carrier for the colorant.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica Faison-Gee whose telephone number is 571-

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272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

vfg
1-7-08



J. A. LORENGO
SUPERVISORY PATENT EXAMINER